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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,233	11/12/2003	Charles C. Willis	01621.84066-001	6393
24335	7590	12/13/2005	EXAMINER	
WARNER NORCROSS & JUDD LLP 900 FIFTH THIRD CENTER 111 LYON STREET, N.W. GRAND RAPIDS, MI 49503-2487			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/706,233	Applicant(s) WILLIS ET AL.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-12 and 14 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 13 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03312005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 23, 2005.
2. Applicant's election with traverse of Invention I in the reply filed on September 23, 2005 is acknowledged. The traversal is on the ground(s) that, since the phrase "formed with a mold in a molding operation" was added to the independent claims, the article of footwear cannot be formed by the proposed "materially different" process of bonding pieces together. This is not found persuasive because the addition to the independent claims only places that portion of the claim in a product-by-process claim and therefore, only the product needs to be found since applicant is not claiming the process in independent claims 1 and 10. Therefore, the restriction as previously applied still remains intact. The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansfield et al. 6,594,922 in view of Snyder et al. 6,286,232 or Xia et al. 6,481,120. Mansfield et al. '922 discloses all the limitations substantially as claimed including the following: (see Figures 5 and 6) an article of footwear (see Figures 5 and 6); an upper 40 including a lower portion (that located just above the interior 34); a midsole 32 (also including 2 in Figure 6) extending along a length between a forward most portion

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and a rearward most portion (See Figures 5 and 6); said midsole including opposing sidewalls (the sides of the midsole) that extend from said rearward most portion to said forward most portion and form a visible exterior of said midsole (see Figures 5 and 6); said midsole including an upper surface (top surface of 32 or 2) and a bottom surface (bottom surface of 32); said upper surface direct attached to said lower portion of said upper (see col. 9, lines 20-42); an outsole joined with said bottom surface of said midsole (see col. 9, lines 26-33); said outsole is substantially flat (see Figures 5 and 6 reference number 30); the midsole bottom surface includes a periphery corresponding to the shape of a wearer's foot (see 32 in Figures 5 and 6); the outsole terminates with the midsole bottom surface so that the side wall is substantially uncovered by the outsole (see Figures 5 and 6); the upper includes an insole 34, said insole joined with the lower portion of the upper to close the upper (see assembly diagram in Figures 5 and 6); the midsole is formed with opposing side molds abutted against a lower mold along a seam, wherein the midsole bottom surface trim corresponds to the seam.(product-by-process portion of claim, not necessary to find since applicant is claiming the product and not the process); an upper 40; a midsole (32, 2) including a lateral side wall, a medial side wall, an upper surface direct attached to said upper, and a bottom surface (as noted above); said bottom surface bounded along a medial edge by said medial side wall and a lateral edge by said lateral side wall (See Figures 5 and 6); said medial side wall and said lateral side wall extending upwardly from said bottom surface to said upper (side walls extend from lower surface to upper surface); an outsole 30 joined with said midsole bottom surface (see Figures 5 and 6); said outsole is substantially flat and extends substantially only across said width (See Figures 5 and 6); the upper includes a lower portion (that attached to the interior 34) and an insole 34 is secured to the lower portion, wherein the midsole is direct attached to the insole (see Figures 5 and 6). Mansfield '922 does not disclose a trim line located on the bottom of the midsole. Snyder et al. '232 and Xia et al. '120 each teach that a sole placed within the shoe can have multiple trim lines located on it, inside the lateral and medial side walls and non-coincident with the sidewalls, to allow the user to trim the sole to the size

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needed by the user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place trim lines, such as those taught by Snyder et al. '232 and Xia et al. '120, on the top and bottom surface of the midsole of Mansfield et al. '922 to shoe the manufacturer where to trim the midsole for the size shoe being fitted to.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 above in view of Schaefer 6,167,640 or Clements 6,601,319. The references as applied to claim 1 above disclose all the limitations of the claim except for the lower portion of the upper having a peripheral edge bent inward toward the center of the shoe. Clements '319 and Schafer '640 each teach that the upper of the shoe can have a peripheral edge (see 6 in Figure 1 of Schafer '640 and the bottom edge of 19 in Clements '319) turned in towards the center of the shoe, typically termed a "lasting margin", which would allow for the upper of the shoe to have a greater surface area in contact with the sole to which it is attached to give a better hold of the upper to the sole. Therefore, it would have been obvious, in view of Schafer '640 or Clements '319, to turn inward the bottom periphery of the upper of the references as applied to claim 1 above to allow for a larger lasting margin or area of attachment of the shoe upper to the sole for a stronger hold.

Allowable Subject Matter

5. Claims 7-8, 13 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

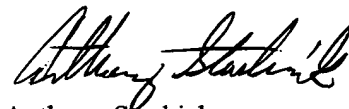
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on Form 892 enclosed herewith.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS